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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,028	02/27/2002	Ursula Murschall	01/036 MFE	8414
7590	06/05/2003			
ProPat, L.L.C. 2912 Crosby Road Charlotte, NC 28211-2815			EXAMINER DICUS, TAMRA	
		ART UNIT 1774	PAPER NUMBER 3	
		DATE MAILED: 06/05/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	<i>H</i>
	10/084,028	MURSCHALL ET AL.	
Examiner	Art Unit		
Tamra L. Dicus	1774		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 May 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to a white biaxially oriented film classified in class 428 subclass 221.
  - II. Claims 14-18, drawn to a process for producing a white, biaxially oriented film classified in class 427, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the film of I can be made by eliminating the winding up the film step.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Klaus Schweitzer on 5/31/03 a provisional election was made with traverse to prosecute the invention of I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Objections***

6. Claim 10 is objected to because of the following informalities: the organic phosphorous compound is misspelled, e.g. ...5-ylmethyl... Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what regrind encompasses. The specification is absent from containing what material this is of.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4-5, 7 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,270,888 to Rutter et al.

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10. Rutter teaches various polymeric films, preferably one of which is of polyethylene terephthalate, especially one that has been biaxially oriented at col. 2, lines 20-24. Additives consist of UV absorbers/stabilizers such as triazines (providing the other functionality, addressing claims 4, 5, and 7), dyes or pigments, and also includes titania (brightener, inherently produces white color, claim 1) at col. 3, line 1, and lines 27-35. See col. 5, lines 7-22 and col. 6, lines 30-37. See Example 1 teaching a film thickness of 25 microns, meeting the limitation from 10 to 500 microns.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3, 6, and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,270,888 to Rutter et al. above in view of USPN 4,033,936 to Bollert et al. and USPN 5,075,481 to Hofmann et al..

Rutter essentially teaches the claimed invention. Rutter does not disclose adding a concentration of white pigment in the range between 2.0 and 25.0 %. However, such an amount is obvious to optimize as it merely changes the color density of the film. It would have been obvious to one of ordinary skill in the art to modify the film of Rutter to adjust the titania concentration to adjust the whiteness color level since it has been held that discovering an optimum value of a result

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effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The concentration of titania effects the color-opacity of the film.

13. Rutter does not disclose a flame retardant is an organic phosphorous such as carboxyphoshinic acid or anhride as in instant claims 8 and 9. However, Bollert teaches it is conventional to add carboxyphoshinic acids and other anhydrides to polyesters (polyethylene terephthalate (PET) is inclusive) at col. 1, line 65-col. 2, line 7 to provide flame retarding properties. Hence it would have been obvious to one of ordinary skill in the art to modify the polymeric film of Rutter in further include carboxyphoshinic acids and other anhydrides for the purpose of providing flame retarding properties as taught by Bollert at col. 1, lines 54-63.

14. Rutter does not teach an organic phosphorus compound is the compound recited in instant claim 10. Rutter does not teach adding phenolic stabilizers of claim 11. Rutter does not teach adding from 0.05 to 0.6% of phenolic stabilizer or the molar mass above 500 g/mol. However, Hoffman teaches in Example 1 a very similar in structure compound useful for stabilizing PET (see col. 3, lines 29-45 and col. 4, lines 55-62). Hoffman also teaches adding phenolic stabilizers/antioxidants and alkaline earth metal sterates such as Mg stearate at col. 9, lines 29-50 are conventional additives. Such additives are added from 0.1 to 5% (meeting range limitations of claim 12 from 0.05 to 0.6%) at col. 6, lines 5-8. The molar mass is inherent to the composition since the same material and ranges are taught. Hence one would have be motivated to include such aforementioned additives in the ranges taught to the film of Rutter since Hoffman teaches it is conventional to do so for producing fire retarding polyethylene compositions as cited above.

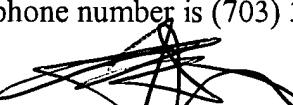
***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,800,962 to Benzing et al. teaches temporary support film for transferring white pigment layer containing biaxially oriented PET, white pigment, optical brighteners, and UV absorbers. USPN 5,306,606 to Tachibana et al. teaches a biaxially stretched polyester film comprising a coating layer. USPN 5,798,433 to Schmidt et al. teaches processing polypropylene terephthalate including UV absorbers, optical brighteners, and white pigments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Tamra L. Dicus  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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May 31, 2003

